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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,098	07/31/2003	Steven H. Voldman	BUR9-1999-0193US2	7752
21254	7590	09/22/2004	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			NGUYEN, LONG T	
			ART UNIT	PAPER NUMBER
			2816	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,098

Applicant(s)

VOLDMAN, STEVEN H.

Examiner

Long Nguyen

Art Unit

2816

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-13, 15, 19, 20, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Specie II (Figures 5-6) in the reply filed on 8/31/04 is acknowledged. Note that applicants identify that claims 14, 16-18 and 21 read on Specie II (Figures 5-6).

Claim Objections

2. Claims 14, 16-18 and 21 are objected to because of the following informalities:

Claim 1, line 6, it is suggested to change "a circuit control network" to --a control network circuit-- so that it is consistent with the language of all the claims (see line 1 of claims 16-18).

Claims 16-18 and 21 are objected to because they include the informality of claim 16.

Also, claim 16 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Note the limitation "said control network circuit modulates said potential voltage said body" already recites in claim 14 (lines 6-7).

Also, in claim 21, line 1, it is suggested to insert --circuit-- after "network".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 14, 16-18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 14, the phrase “resistive/capacitor” is indefinite because it is not clear whether “/” means “and” or “or”.

Claims 16-18 and 21 are rejected because they include the indefiniteness of claim 14.

Also, with respect to claim 21, the recitation “said control network comprises n-channel and p-channel SOI MOSFETs, at least two RC discriminators and at least one control circuit network” is indefinite because it is not clear how can a control network can comprises at least one control circuit network and also comprising other elements (n-channel and p-channel SOI MOSFETs, at least two RC discriminators). Further, it appears that such recitation in the claim is misdescriptive because the disclosure does not disclose any control network circuit which comprises “comprises n-channel and p-channel SOI MOSFETs, at least two RC discriminators and at least one control circuit network” as claimed. Further, the claims would also be indefinite because there is no connection between the elements (i.e., n-channel and p-channel SOI MOSFETs, at least two RC discriminators and at least one control circuit network), so the relationship between these elements cannot be understood and therefore it is not clear how the circuit works. Clarification and/or appropriate corrections is requested.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (USP 5,682,050) in view of Brady et al. (USP 5,314,841).

With respect to claims 14 and 16-18, Figure 13A of the Williams reference discloses a device which includes: a gate (of M), a body (of M); a resistive/capacitor discriminator circuit (RG-GD1, note that for broadest reasonable interpretation the circuit RG-GD1 includes resistor so it meets the limitation “resistive/capacitor” because the examiner treats “/” means “or”), and a control network circuit (D8, D9, RB, M2, D7) modulating a potential of the body (of M) to provide ESD protection (the circuit of D8, D9, RB, M2, and D7 in Figure 13 capable of controlling the potential biasing the body of the transistor and therefore it also capable of provide ESD protection). The Williams reference does not disclose that the circuit in Figure 13A was fabricated by using silicon-over-insulator SOI technology. However, the Brady et al. reference discloses that silicon-over-insulator (SOI) technology provides advantages over regular silicon technology such as increasing the operating speed and reducing the power consumption of the circuitry (Col. 1, lines 12-15). Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the circuit in Figure 13A of the Williams reference to use the SOI technology to fabricate the circuit for the purpose of increasing the operating speed and reducing the power consumption of the circuitry. Thus, this modification meets all the limitation of claims 14 and 16-18. Note that, in the above modification, the functional limitations in claims 16-18 are also met as the operation of control network circuitry modulates the potential voltage of the body and limit the body to a reference voltage (by D8, D9, RG, D7 and M2), and the control network including a SOI MOSFET (M2)

Conclusion

7. Because the scope of claim 21 cannot be determined at this time due to the indefinite problem as discussed above. No prior art can be applied against this claim at this time. Note that this is not an indication of allowability.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directly to Examiner Long Nguyen whose telephone number is (571) 272-1753. The Examiner can normally be reached on Monday to Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Callahan, can be reached at (571) 272-1740. The fax number for this group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 20, 2004



Long Nguyen
Primary Examiner
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